



PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

AF-1
1600**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/367,013
	Filing Date	August 5, 1999
	First Named Inventor	Deborah KNUTZON
	Art Unit	1652
	Examiner Name	NASHED, Nashaat, T.
Total Number of Pages in This Submission	Attorney Docket Number	15611-7032

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input checked="" type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
RECEIVED FEB 18 2004		
RECEIVED FEB 18 2004		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Bingham McCutchen LLP
Signature	<i>David W. Maher</i> Reg. No. 40,077
Date	February 6, 2004

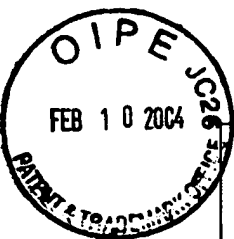
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	David W. Maher		
Signature	<i>David W. Maher</i>	Date	February 6, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Certificate of Mailing/Transmission (37 C.F.R. § 1.8(a)):

☒ Pursuant to 37 C.F.R. § 1.8, I hereby certify that this paper and all enclosures are being deposited with the United States Postal Service as first class mail on the date indicated below in an envelope addressed to: Commissioner for Patents, Washington D.C. 20231.

☐ Pursuant to 37 C.F.R. § 1.6(d), I hereby certify that this paper and all enclosures are being sent via facsimile on the date indicated below to the attention of Examiner _____ at Facsimile No. _____ at _____ a.m./p.m.

Dated: February 6, 2004

Name of Person Certifying: David W. Maher

Printed Name: David W. Maher

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Deborah Knutzon et al.
Assignee: Calgene LLC /Abbott Laboratories
Filing Date: August 5, 1999
Serial No.: 09/367,013
Title: METHODS AND COMPOSITIONS FOR SYNTHESIS OF LONG CHAIN POLYUNSATURATED FATTY ACIDS

Examiner: Nashed, Nashaat T.
Art Unit: 1652

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.181

RECEIVED
FEB 18 2004

Sir:

In accordance with 37 CFR § 1.144, Applicants petition under 37 CFR § 1.181 for relief from the withdrawal of claims 189-214 and 285-290 from consideration. A Notice of Appeal is being filed simultaneously with this petition. Accordingly, under 37 CFR § 1.144, this petition is timely filed.

STATEMENT OF FACTS

This application was filed with claims 1-188 on Aug. 5, 1999 as a 371 of PCT/US98/07126 filed Apr. 10, 1998, claiming priority to U.S. App. Ser. No. 08/834,655 filed Apr. 11, 1997. A Restriction Requirement was made dated May 8, 2001 (see Exhibit A), dividing the claims into 12 groups, further requiring a species election. Applicants elected group I without traverse and stearidonic acid as the species in their response of July 31, 2001. Subsequently, claims 189-284 were added in a response filed Apr. 12, 2002 (see Exhibit B), and claims 189-214 were withdrawn from consideration in the Office Action of June 28, 2002. Reconsideration of the withdrawal was requested in Applicants' response of Oct. 28, 2002 (pages 16-17 of Exhibit C) and claims 285-296 were added. Claims 285-291, 293 and 294 were withdrawn from consideration in the Office Action mailed Dec. 31, 2002, and reconsideration of the withdrawal was requested in the response filed June 30, 2003 (pages 6-7 of Exhibit D), in which claims 197, 198, 209, 245-254 and 291-296 were cancelled.

POINTS TO BE REVIEWED

Claims 189-196, 199-208 And 210-214 And 285-290 Are Within The Elected Invention Under PCT Rules

The Office Action of June 28, 2002 stated that claims 189-214 and 215-284 were drawn to two independent methods which do not relate to a single inventive concept under PCT Rule 13.1. The Office Action of Dec. 31, 2002 stated that claims 185-214, 291 and 294 were not in Group I elected by Applicants.

The single inventive concept to which all the claims relate is a product that is a microbial cell culture with an altered fatty acid profile by virtue of expression of a sufficient amount of a $\Delta 6$ -desaturase. Claims 189-214 relate to a method for production of this product, and claims 215-284 relate to a method of use of this product to produce an oil with an altered fatty acid profile. Claims 285-290 relate to the microbial culture itself. These claims were not restricted from each other in the original restriction requirement. The subsequent withdrawal of claims 189-196, 199-208 and 210-214 and 285-290 from consideration was timely traversed.

MPEP 1850.C. (p. 1800-62) states:

“The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product. ...

The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process.” (emphasis added)

Here, applicants have presented claims for a method of making a given product, claims for a method for use of that product, and claims to the product itself. The MPEP states that these sets of claims share unity of invention under PCT rules.

ACTION REQUESTED

In accordance with MPEP 1850.C. and PCT Rule 13, Applicants request that the withdrawal of claims 189-214 and 285-290 be found improper and that such claims be considered, as they share unity of invention.

CONCLUSION

Applicants respectfully petition for reconsideration of the claims in view of the above remarks. A notice of allowance is earnestly solicited. If a telephone conference would expedite allowance of this matter, the Examiner is welcome to contact the undersigned at (650) 849-4908.

If an appropriate payment does not accompany or precede this submission, the Commissioner is hereby authorized to charge any required fees, including any petition for extension of time, or to credit any overpayment, to Deposit Account No. 50-2518, billing reference no. 7000934001.

Respectfully submitted,

By: 

David W. Maher

Reg. No. 40,077

Bingham McCutchen LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4908
Telefax: (650) 849-4800